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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,711	10/27/2003	Jason C. Birnholz	28,441-A	1581

7590

05/17/2006

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EXAMINER

AHMED, HASAN SYED

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/693,711	JASON C. BIRNHOLZ	
	Examiner	Art Unit	
	Hasan S. Ahmed	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Receipt is acknowledged of the application filed on 27 October 2003.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Objections

Claim 2 is objected to because of the following informality: claim 2 recites "...silicone oil soluble antiseptic and antimicrobial properties." The term "soluble" is not a proper descriptor for "properties." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2 and 3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claim 2 recites "...silicone oil soluble antiseptic and antimicrobial properties." However, the specification provides no description or examples of antiseptic or antimicrobial properties of the claimed silicone oil.

Claim 3 recites "...oil soluble materials for stimulating nerve end sensation." However, the specification provides no description or examples of the capacity of oil soluble material to stimulate nerve end sensation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 teaches use of the claimed composition on "tissues" then goes on to limit that generic concept to a specific tissue, i.e. dermal tissue. Such inconsistency renders the claim indefinite.

Claim 1 recites "...in the absence of application of cosmetic substances..." This limitation renders the claim indefinite as it is unclear what particular substances applicant considers "cosmetic substances." Furthermore, this limitation provides no context as to the physical location or temporality of application of "cosmetic substances" vis-à-vis the claimed composition.

Claim 3 teaches use of generic "oil soluble materials." However, the claim does not specify which oil soluble materials are to be used.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singleton, et. al. (U.S. Patent No. 6,200,964).

Singleton, et. al. teach a silicone gel comprising a silicone polymer and a volatile liquid (see col. 1, lines 35-56).

A disclosed silicone polymer is polysilicone-11, a cross-linked silicone rubber (see col. 3, line 1). A disclosed volatile liquid is cyclopentasiloxane (see col. 3, line 41). Oil soluble materials such as antioxidants, castor oil and avocado oil are also disclosed (see col. 2, line 10; col. 5, lines 52-65).

Singleton, et. al. explain that a composition comprising a silicone based gel and a volatile liquid is beneficial because the silicone gel releases the volatile liquid, which in promotes absorption of excess skin oil into the oil-swellaable silicone polymer. This property mitigates the clogging of dermal pores, thus inhibiting the formation of comedones. The disclosed gel also diminishes light reflection from the skin, thus providing the skin with a smooth matte appearance. See col. 3, lines 12-25.

While Singleton, et. al. do not explicitly teach all the instant claimed percentages or viscosity, it is the position of the Examiner that it would have been obvious to one of ordinary skill in the art at the time the invention was made to determine suitable

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percentages and viscosity through routine or manipulative experimentation to obtain the best possible results, as these are variable parameters attainable within the art.

Moreover, generally, differences in concentration or viscosity will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or viscosity is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456; 105 USPQ 233, 235 (CCPA 1955). Applicants have not demonstrated any unexpected or unusual results, which accrue from the instant percentage or viscosity ranges.

The prior art clearly teaches use of as much as 90% of the silicone polymer and as little as 1% of the volatile liquid (see col. 1, lines 57-63). The viscosity disclosed is as high as 25,000 cps (see col. 7, lines 35-37).

No patentable weight is given to the intended use of the instant composition as a "personal lubricant."

A person having ordinary skill in the art at the time of the invention would therefore find motivation to combine a cross-linked silicone rubber and cyclopentasiloxane in a paste formulation as taught by Singleton, et. al. Motivation to combine these ingredients would come from oil absorption and aesthetic properties, as discussed above.

Therefore, those of ordinary skill in the art would expect similar properties from the instant composition, given the teachings of Singleton, et. al. The instant invention would have been obvious, given the teachings of Singleton, et. al.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hasan S. Ahmed whose telephone number is 571-272-4792. The examiner can normally be reached on 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'MPW', is positioned above the printed name of Michael P. Woodward.

MICHAEL P. WOODWARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600